

Remarks

The finality of the Rejection

The Examiner made the official action dated March 3, 2004 "final". With all due respect to the Examiner, since the rejections under 35 USC 112 set forth in the current official action represent a new theory by the Examiner for rejecting the claims and since the new grounds for rejection was not triggered by any amendment made by applicant, the finality of the current rejection is premature.

The fact that final rejection is premature was discussed with the Examiner in a telephone discussion with the undersigned on May 18, 2004. During that telephone discussion the Examiner agreed to withdraw the finality of the official action. The Examiner is thanked for agreeing that the official action should not have been made final.

The Examiner's Assertion

During the telephone discussion the Examiner asserted that the examined claims need to be amended (narrowed) to point more directly at what the Examiner regards as being the disclosed invention. The Applicant is responding to this assertion in two ways. First, as will be developed in greater detail below, the Applicant believes that the current claims are proper and should be allowed. Second, with the withdrawal of the finality of the rejection, the Applicant has taken this liberty of presenting additional claims that are either different, or in at least some cases, narrower than the examined claims for the Examiner to also consider. These additional claims are intended to clarify just what are the Examiner's objections to the examined claims should it become necessary to pursue this matter at the Board of Appeals.

The rejection under 35 USC 112, second paragraph

Claims 1-8 are rejected under 35 USC 112, second paragraph in the present official action. The Examiner rejects claim 1 since the language of claim 1, as “emphasized” by Applicant is subject to multiple interpretations. The Applicant has a couple of observations to make in response:

(1) The Examiner talks about the “emphasis” provided by the Applicant with respect to the quoted claim language. In the last response the Applicant merely quoted the language of claim 1 which could not be found in the prior art reference. The Applicant quoted the language verbatim. No intended (or unintended) interpretation of the claim language was set forth in the response.

(2) As the Examiner himself acknowledges (see the first whole paragraph on page 4 of the official action where the Examiner cites *In re Van Geuns*), **the claims are supposed to be interpreted in light of the specification**. If the Examiner is trying to come up with claim interpretations that are at odds with the disclosure, then that action is improper as the Examiner acknowledges. If the claims can be read on multiple embodiments, then there is nothing wrong with that. The Examiner is invited to read those portions of the MPEP that deal with election of species and the fact that an application can have generic claims. The Applicant believes that there is nothing in the US Patent Law that requires that the claims be limited solely to the disclosed embodiment(s). Otherwise, an application would only have a single claim that would be as long as the specification.

The rejection is non-statutory and the Applicant respectfully requests that it be withdrawn.

The prior art rejections

The gist of the Examiner's comments in the official action and the Examiner's comments made during the telephone discussion with the undersigned (reported above), seems to suggest that the Examiner believes that the claims are too short (i.e. that they should have more words). The Applicant has the following observations to make on this issue:

(1) It is not believed that the Patent Statute requires claims to have some minimum number of words. If the Examiner disagrees then the Examiner is respectfully requested to cite the statutory provision(s), rule(s) or case law that support his apparent position.

(2) As the Examiner himself acknowledges in first whole paragraph on page 2 of the official action, Congress, in its wisdom, gave the Applicant the privilege of deciding the subject matter to be claimed. Note that the claims are to be directed to the "subject matter which applicant regards as the invention." 35 USC 112 gives the Applicant, as opposed to the Examiner, the privilege of deciding the subject matter to be claimed. It is understood that the Examiner would like to see the claims written differently. But that is not a ground for rejecting the claims.

Turning now to the prior art based rejections, the Examiner is again reminded that MPEP 2131 states that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," quoting *Verdegaal Bros v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

In the official action the Examiner makes a number of assertions. On page 3 the Examiner asserts that he is entitled to ignore the preamble of a claim and cites *In re Hirao and Sato*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) as supporting his position. The Examiner apparently has not read that decision and therefore a copy of same is appended to this response. Instead of supporting the examiner's contention, *In re Hirao and Sato* stands for the proposition that the claim must be

considered as a whole. The Patent Office Solicitor in that case was basically complaining that the novelty-conferring feature was not in the preamble. The court makes it clear that the novelty-conferring feature need not be in the preamble of the claim and it is quite okay if a novelty-conferring feature is in the body of the claim. But the case does not stand for the proposition asserted by the Examiner, namely, that a preamble may be ignored.

It is also noted that the Examiner did not ignore the preamble in the first official action. It is obvious that the Examiner does so now in an effort to try to reject the claims as opposed to either locating prior art that might be more relevant to Applicant's claims or confirming that such art does not exist.

Nevertheless, in a spirit of cooperation, claim 1 has been amended to also recite portions of the preamble in the body of the claim

Turning to the examiner's comments in the paragraph bridging pages 3 and 4 of the official action, the Applicant asked the Examiner where the limitation "opening and maintaining an information block flow by sending repeated message blocks which are defined at a selected layer in the protocol stack below the topmost layer" was allegedly shown in the cited art. The Applicant did not interpret the language of the claims one way or another. The Applicant only asked where the cited Sato document allegedly taught certain limitations of claim 1. It is noted that the Examiner still has not shown where Sato teaches the noted limitation, nor has the Examiner shown where Sato teaches "calculating said block error rate measurements based at least in part on the monitored ack/nack messages".

On page 5 of the official action the Examiner asserts that "errors occur randomly." The Applicant agrees that errors can occur randomly. So if a random transmission error occurs in a block of data, why is the random occurrence of an error a predetermined characteristic of the block? No one knows in advance when an error will occur. Errors occur randomly. They are the antithesis of a

predetermined event. So why is the Examiner equating a random event with a “predetermined characteristic which causes the message blocks to be discarded upon processing at the selected protocol layer in a communications unit receiving the message blocks” as specifically recited by claim 2? In the prior art the event “which causes the message blocks to be discarded upon processing at the selected protocol layer in a communications unit receiving the message blocks” is a random event and not a “predetermined characteristic” of the transmitted message blocks.

New claim 22 recites that “at least some of the message blocks are intentionally constructed to be discarded following receipt and processing thereof to return an ack/nack message.” It is hoped that the Examiner will not equate “intentionally constructed” with a random error event.

New claims 9 and 17 each recite “measuring block error rate as a predetermined function of occurrence of monitored nack messages”, which serves to differentiate them from Sato.

New claims 20 and 21 each recite “a monitor for monitoring ack/nack messages sent in response to the message blocks to determine whether the message blocks have been correctly transported, and for measuring block error rate as a predetermined function of occurrence of monitored nack messages”, which serves to differentiate them from Sato.

Reconsideration is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to

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Amendment B

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make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

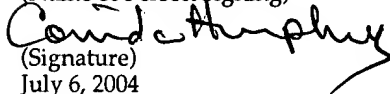
I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents POB 1450, Alexandria, VA 22313-1450 on

July 6, 2004

(Date of Deposit)

Corinda Humphrey

(Name of Person Signing)

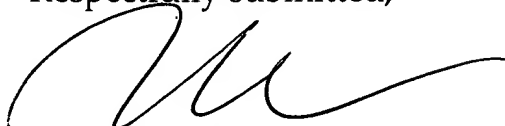


(Signature)

July 6, 2004

(Date)

Respectfully submitted,



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response to Airtex's mailing of notices of infringement to 16 Shelley customers. The district court found nothing in the letters actionable and held that "[a] good faith belief that a patent is being infringed, particularly when promptly followed up by filing a lawsuit in good faith, is a defense to a charge of unfair competition," citing *Virtue v. Creamery Package Mfg. Co.*, 227 U.S. 8, 37-38 (1913), and *Applied Biochemists, Inc. v. A and V Inc.*, 353 F.Supp. 949, 177 USPQ 224 (E.D. Wis. 1973). We have reviewed the letter and agree that it contained no disparaging remarks. Nothing in the record sufficiently indicates bad faith on the part of Airtex in either its belief that the Beck patent was valid or its motive in sending the notices. We believe a further indication of its good faith is the fact that the notices were selectively sent only to those architects, contractors, and others who were in fact considering the purchase of Shelley panels rather than an indiscriminate wholesale mailing of notices to anyone who might be interested in radiant heating and cooling panels.

Accordingly, the judgment of the district court is affirmed in all respects.

Court of Customs and Patent Appeals

In re Hirao and Sato

No. 76-560 Decided May 27, 1976

PATENTS

1. Patentability — Invention — In general (§51.501)

Patentability — Subject matter for patent monopoly — Process, product and apparatus (§51.613)

Subject matter, as whole, of three-step process whose third step used known product, produced by first two steps, in obvious way, would not have been obvious to one of ordinary skill in art at time invention was made, due to admitted nonobviousness of first two steps.

2. Patentability — Invention — In general (§51.501)

Patentability — Subject matter for patent monopoly — Process, product and apparatus (§51.613)

It is improper to determine obviousness of three-step process by merely asking whether, given product of two unobvious claimed steps, third claimed step of using product would have been obvious; obviousness of invention as whole, which includes unobvious first two steps, must be determined.

3. Claims — Article defined by process of manufacture (§20.15)

Claims — Process (§20.80)

Patentability — Subject matter for patent monopoly — Process, product and apparatus (§51.613)

Product-by-process claim, although reciting subject matter of claim in terms of how it is made, is still product claim; it is patentability of product claimed and not recited process steps that must be established, in spite of fact that claim may recite only process limitations; analogy to product-by-process claims is inapposite in case in which three-step process, not product formed by two steps of process or third step of using product, is claimed; Court of Customs and Patent Appeals does not construe product-by-process claims in ex parte case as limited to product formed by specific process recited.

Particular patents — Preparing Food

Hirao and Sato, application, Process for Preparing Food and Drinks, rejection of claims 1-4, 10, 17-19, 21, 22, and 24-26 reversed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Mamoru Hirao and Yoshinori Sato, Serial No. 839,689, filed July 7, 1969. From decision rejecting claims 1-4, 10, 17-19, 21, 22, and 24-26, applicants appeal. Reversed.

See also 188 USPQ 248.

Roger L. Browdy, Washington, D.C., for appellants.

Joseph F. Nakamura (Gerald H. Bjorge, of counsel) for Commissioner of Patents and Trademarks.

Before: Markey, Chief Judge, Rich, Lane, and Miller, Associate Judges, and Almond, Senior Judge.

Miller, Judge.

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This appeal is from the decision of the Patent and Trademark Office Board of Appeals affirming the rejection of claims 1-4, 10, 17-19, 21, 22, and 24-26 in application serial No. 839,689, filed July 7, 1969, for "Process for Preparing Food and Drinks." We reverse.

The Invention

The invention involves a process of sweetening foods and drinks. The process comprises three steps, the first two being a method of forming a high purity maltose product (which is the sweetening agent) and the third being the use of this product to sweeten the food or drink. Claim 1, the sole independent claim, is illustrative (paragraphing and numbering added):

1. A process for preparing foods and drinks sweetened mildly, and protected against discoloration, Strecker's reaction, and moisture absorption, which comprises:

[1] adding a-1, 6-glucosidase and b-amylase, under such conditions and in a quantity sufficient to produce straight chain amylose, to enzymatically liquefied starch which consists essentially of amylopectin thereby producing straight-chain amylose;

[2] subjecting the resulting amylose to the action of b-amylase and purifying and drying to obtain high purity maltose in crystalline powder form of 90 - 95% maltose; and then

[3] adding said high purity crystalline maltose powder to foods and drinks as the essential added sweetener.

The Board's Opinion

The board, in a new ground of rejection under 37 CFR 1.196(b), found that all of the claims now before the court would have been obvious under 35 USC 103 in view of Jacobs (Jacobs, Chemistry and Technology of Food and Food Products 67-70 (1951)) together with Kjolberg (Kjolberg et al., Studies on Carbohydrate Metabolizing Enzymes, 86 J. BIOCHEMISTRY 258-62 (1963)). (The references are discussed infra under "Agreed Statement.") The board stated:

We wish to make it clear that while appellants' method of making high purity maltose appears to be unobvious based on the art of record before us, the method of sweetening food products with high purity maltose would be obvious from the teaching of Jacobs in view of Kjolberg:

In response to a request for reconsideration, the board further stated:

We note that appellants concede that the method of sweetening food products with high purity maltose would be obvious from the teachings of Jacobs in view of Kjolberg et al. As to claim 1, it is our considered opinion that, regardless of the process employed in preparing high purity maltose, it is obvious to use such high purity maltose in sweetening food products.

Agreed Statement

This appeal comes before the court on an agreed statement of the case¹ under court Rule 5.5.² The following facts, among others, have been stipulated:

9. Claim 1 is an independent claim on which each of the remaining appealed claims depends, directly or indirectly.

10. The rejection of dependent claims 2 to 4, 10, 17 to 19, 21, 22 and 24 to 26 will stand or fall with the rejection of claim 1.

11. The sole issue to be decided by the present appeal is whether claim 1, and all those claims dependent therefrom, are obvious in the sense of 35 USC 103 over Jacobs in view of Kjolberg.

* * *

13. The Kjolberg reference teaches one process of making high purity maltose.

14. The Jacobs reference generally teaches that certain undefined maltose products may be used for sweetening food products.

15. Appellants' steps of making high purity maltose, which appear as the first two steps in claim 1 * * *, are novel and unobvious based on the art of record.

16. Appellants' step of adding high purity maltose to foods and drinks as the

¹ See In re Hirao, 525 F.2d 1066, 188 USPQ 248 (CCPA 1975).

² Rule 5.5:

When the questions presented by an appeal to this court can be determined without an examination of all the pleadings, evidence, and proceedings below, the parties may submit an agreed statement of the case in lieu of the record as required by Rule 3.3(b) showing: (1) how the questions arose and were decided in the tribunal from which the appeal is taken; (2) the facts averred and proved or sought to be proved which are essential to a decision of the questions by this court; and (3) a concise statement of the issues to be decided and the points to be relied on by appellant. The statement shall be accompanied by a certified copy of the judgment or ruling appealed from and a certified copy of all opinions, if any, in support thereof.

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Appellants concede that sweetening food products with maltose would be obnoxious to Jacobs in view of his claim 1, it is our opinion that, regardless of the facts, preparing high purity maltose for use such as high purity maltose in sweetening food

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independent claim on the remaining appealed claims directly or indirectly. The rejection of dependent claims 21, 22 and 24 to 26 will be the rejection of claim 1. The issue to be decided by the court is whether claim 1, and all claims dependent therefrom, are obvious under 35 USC 103 over the prior art. *See* *Ex parte* *Sjolberg*.

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presented by an appeal determined without an examination of the pleadings, evidence, and affidavits, and the parties may submit an affidavit in support of the case in lieu of the brief. The rule 3.3(b) showing: (1) the grounds for the appeal; and were decided in the appeal is taken; (2) the facts of the case proved or sought to be proved; and (3) a concise statement of the law applied and the points at issue. The statement shall be accompanied by a certified copy of the record on which the appeal was based from and a certificate, if any, in support

essential added sweetener, which appears as the third step in claim 1, * * * would be obvious from the teachings of Jacobs in view of Kjolberg.

Opinion

[1] As stipulated, the first two steps (forming high purity maltose) would have been unobvious from the art of record, while the third step (using high purity maltose as a sweetener) would have been obvious in view of Jacobs together with Kjolberg. Moreover, the Solicitor has stated—without contravention by appellants—that the high purity maltose product formed by the first two steps and the high purity maltose product of the prior art “may be considered the same as far as the process and use recited in the preamble and step [3] of claim 1 are concerned.” Thus, the single issue is whether appellants’ three-step process is obvious, the first two steps being unobvious but forming a known product, and the third step being the use of this known product in an obvious way. We conclude that due to the admitted obviousness of the first two steps of the claimed combination of steps, the subject matter *as a whole* would not have been obvious to one of ordinary skill in the art at the time the invention was made. Cf. *In re Mancy*, 499 F.2d 1289, 182 USPQ 303 (CCPA 1974); *In re Kuehl*, 475 F.2d 658, 177 USPQ 250 (CCPA 1973).

[2] The Solicitor argues that Kuehl and its progeny (including Mancy) are distinguishable, "inasmuch as the Court was there concerned with the obviousness of processes of using unobvious products," while here "the person of ordinary skill in the art has already been given the obvious, high purity maltose produced by other processes." However, this factual distinction does not preclude the applicability to the present case of the reasoning of Kuehl, where this court said (*supra* at 664-65, 177 USPQ at 255):

[W]e think [In re Saunders, 33 CCPA 1001, 154 F.2d 693; 69 USPQ 341 (1946)] no longer represents viable law to the extent that it supports the broad proposition that the obviousness of process claims drawn to a method of using a composition is determined by asking * * * whether "*given*" the composition the claimed process of use would be obvious. The test under §103 is whether in view of the prior art the invention as a whole would have been obvious at the time it was made, and the prior art here does not include the zeolite [the unobvious composition used] * * *

[Footnote omitted.]

Similarly here, it is improper to determine obviousness by merely asking whether,

given the product of the two unobvious claimed steps, the third claimed step of using the product would have been obvious. The obviousness of the invention as a whole must be determined, and the unobvious first two steps are clearly part of the invention as a whole.

[3] The Solicitor urges that the board committed no error in refusing to give weight to the specific method of making the high purity maltose. He analogizes the present claims to product-by-process claims, stating that "claim 1 may properly be viewed in short hand [sic] form as a 'process of using a product-by-process' claim," and argues that the method limitations of the first two steps should be given little or no weight. A product-by-process claim, although reciting the subject matter of the claim in terms of how it is made, is still a product claim. As this court said in *In re Brown*, 59 CCPA 1036, 1041, 459 F.2d 531, 535, 173 USPQ 685, 688 (1972):

[I]n spite of the fact that the claim may recite only process limitations, it is the patentability of the *product* claimed and *not* of the recited process steps which must be established.

Here, a three-step process is claimed—not the product formed by two steps of the process or the third step of using that product. Thus, the analogy to product-by-process claims is inapposite.³

The Solicitor points to the preamble of claim 1, which recites a "process for preparing foods and drinks sweetened mildly," as showing that the subject matter as a whole involves the use of an old sweetening agent in a very obvious manner. However, the preamble merely recites the purpose of the process; the remainder of the claim (the three process steps) does not depend on the preamble for completeness, and the process

3 At oral hearing, the Solicitor pointed out that some courts in infringement suits have construed product-by-process claims as covering *only* a product made by the particular process set forth in the claims. (See *In re Bridgeford*, 53 CCPA 1182, 1186 n.5, 357 F.2d 679, 682 n.5, 149 USPQ 55, 58 n.5 (1966)), and argued that these courts would treat the "process of using a product-by-process claim," and the present claims in the same manner. This court, however, as recognized by the Solicitor, does not construe product-by-process claims in an *ex parte* case as limited to the product formed by the specific process recited. *In re Avery*, 518 F.2d 1228, 186 USPQ 161 (CCPA 1975). If it did, the Solicitor's analogy to product-by-process claims would fall under its own weight.

steps are able to stand alone. See *Kropa v. Robie*, 38 CCPA 858, 187 F.2d 150, 88 USPQ 478 (1951). The Solicitor's interpretation of the preamble would improperly broaden the scope of the claim.

In view of the foregoing, we hold that the subject matter as a whole would not have been obvious at the time the invention was made.

The decision of the board is reversed.

Patent and Trademark Office Trademark Trial and Appeal Board

Manpower, Inc.
v. Manpower Information Inc.

Decided Jan. 29, 1976

As amended June 7, 1976

TRADEMARKS

1. Opposition — Notice of opposition — In general (§67.5871)

Opposition — Pleading and practice (§67.589)

Although applicant that sought to introduce telephone directory pages, United States Code Annotated indexes, and dictionary pages, but did not indicate material's relevance has not complied with Trademark Rule 123(c), only inference to be drawn from opposer's failure to object when notice was filed is that material's relevance is obvious.

2. Estoppel — Trademarks — Cancellation and opposition (§35.353)

Opposition — Pleading and practice (§67.589)

Trademark Trial and Appeal Board considers estoppel defense, that opposer spent considerable time and effort in its briefs seeking to overcome, even though applicant did not press defense in its brief.

3. Estoppel — Trademarks — Cancellation and opposition (§35.353)

Laches — Trademarks (§44.25)

Opposition — Pleading and practice (§67.589)

Consideration of Lanham Act Section 19 equitable defenses of laches, acquiescence,

and estoppel is not precluded in opposition proceedings, under all circumstances.

4. Laches — Trademarks (§44.25)

Obligation is upon party making defense of laches to show not only inexcusable delay in taking affirmative action against continuing use of mark by said party, or apparent acquiescence in such continued use, but also that prejudice has resulted because of delay and that it would now be inequitable and would impose hardship upon applicant to discontinue use of asserted conflicting mark; in other words, existence of laches defense depends upon equities of case including facts surrounding party's continued use of mark after notice, and not merely upon lapse of time.

5. Estoppel — Trademarks — Cancellation and opposition (§35.353)

Laches — Trademarks (§44.25)

Applicant that offered no evidence as to its investment of time, effort, or money in marks or as to its activities under marks, and whose decision to continue use of mark was dependent on counsel's advice, that there was no likelihood of confusion rather than upon opposer's failure to take affirmative steps to stop applicant's use, has not sustained defense of estoppel by laches.

6. Acquisition of marks — Use of plurality of marks (§67.087)

Identity and similarity — How determined — Adding to other's mark (§67.4053)

Identity and similarity — How determined — Considering other marks (§67.4059)

Addition of house mark to goods is of no significance in opposition to application for registration of mark that does not include housemark; it must be assumed from filing of application that mark in question functions, or is intended to function, as mark in and of itself.

7. Identity and similarity — How determined — Adding to other's mark (§67.4053)

Identity and similarity — Words — Similar (§67.4117)

Addition of descriptive words "Information Service" to applicant's "Manpower" is insufficient to avoid likelihood of confusion.

Trademark opposition No. 55,414 by Manpower, Inc. against Manpower Infor-

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